

Remarks

Claims 65-70 and 84-96 are allowed. Claims 71, 73-76, 79-80 and 83 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 5,410,141 to Koenck et al ("Koenck") in view of U. S. Patent No. 4,721,849 to Davis et al. ("Davis") and U. S. Patent No. 6,292,181 to Banerjee et al ("Banerjee"). Claims 72, 77-78, and 81-82 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Koenck in view of Davis and Banerjee and further in view of U. S. Patent No. 5,825,002 to Roslak ("Roslak"). Applicants have filed a Request For Continued Examination ("RCE") contemporaneously with the present application.

To expedite allowance of claims 65-70, and 84-95 in the event allowance of the remaining claims is delayed, applicants have cancelled allowed claims 65-70 and 84-96 from the present application without prejudice or disclaimer, and have carried those claims forward into a Continuation Application No. (not yet assigned), Attorney Docket No. 283-205.07, filed concurrently and entitled, "Optical Reader System Comprising Host Processor And Optical Reader." The filing of a continuation removes the terminal disclaimer that presently attaches to claims 65-70, and 84-95 in the present application. The Examiner is respectfully requested to consider whether there are considered to be double patenting issues between the present application and Attorney Docket No. 283-205.07. Also, if an Examiner makes additional art of record in one of the applications 09/385,597 (the present application) and the 283-205.07 application, that Examiner is respectfully requested to present those references for consideration by the Examiner of the remaining application.

Independent claim 71 recites:

71. A system comprising:

(a) a optical reader including an imaging assembly, a display, a keyboard, an acoustic output device and a controller configured to capture image data and decode decodable bar code symbols therein, said optical reader further including a hand held housing encapsulating said imaging assembly and said controller, said hand held housing further supporting said display and said keyboard; and

(b) a host processor spaced apart from optical reader, wherein said hand held housing is adapted to be held in a human hand so that said optical reader is moveable between a variety of orientations and distances with respect to said host processor;

(c) wherein said system is configured so that in a first mode said host processor sends to said optical reader a beeper control instruction, wherein said optical reader substantially on receipt of said beeper control instruction actuates said acoustic output device so that said acoustic output device emits a series of beeps;

(d) wherein said system is further configured so that in a second mode said host processor sends to said optical reader a display control instruction, wherein said optical reader substantially on receipt of said display control instruction causes a predetermined indicia to be displayed on said display.

Original Independent claim 76 recited:

76. A method for attracting attention of an operator of a hand held optical reader, said hand held optical reader having an artificial light source, an acoustic output device, a wireless communication link, a display, and being configured to decode decodable bar code symbols represented in captured images, said method comprising the steps of:

- (a) programming said hand held optical reader to wirelessly receive at least one component control instruction from a spaced apart host processor, said component control instruction being selected from the group consisting of a light source flashing component control instruction which when executed by said hand held optical reader results in said artificial light source flashing according to a predetermined pattern, an acoustic output device component control instruction which when executed by said hand held optical reader causes said acoustic output device to emit a series of beeps, and a display output component control instruction which when executed by said hand held optical reader results in a predetermined indicia being displayed on said display, wherein said programming step includes the step of configuring said hand held optical reader to execute said at least one component control instruction to produce a user-perceivable result substantially on receipt of said component control instruction; and
- (b) wirelessly sending from a spaced apart host processor to said hand held optical reader at least one of said light source flashing component control instruction, said acoustic output device component control instruction, and said display output component control instruction, whereby a user-perceivable result is produced by said hand held optical reader substantially on receipt of said at least one component control instruction so that attention of an operator of said hand held optical reader is attracted.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2D 1438 (Fed. Cir. 1991). Cited in MPEP §2143.

Under MPEP §2144, the strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983). The Examiner must present a convincing line of reasoning supporting the rejections. *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) also cited in MPEP §2144.

In rejecting certain claims over the combination of the two references Koenck and Davis, the Examiner admits that that Koenck “fails to teach or fairly suggest the system is configured so that in a first mode the host processor sends to the optical reader a beeper control instruction.” The Examiner also admits that Koenck as modified by Davis “fails to teach or fairly suggest that the system is further configured so that in a second mode the host processor sends to the optical reader a display control instruction.”

In attempting to establish that Koenck and Davis are combinable, the Examiner states that “It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Davis et al into the system as taught by Koenck et al in order to provide Koenck et al with a capability to ensure that the communication between the portable reader and the host computer is proper (*i.e.*, a series of beeps would alert the operator to correct any improper connections) before transmitting information data and thus provide an accurate system.” In attempting to establish that Koenck and Banerjee are combinable the Examiner states that “it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Banerjee et al into the system as taught by Koenck et al/Davis et al in order to provide a user capability to view stored image data in order to verify the accuracy of scanned images, and thus providing an accurate system.” Roslak is asserted to be combinable with the above references because the combination would alert/indicate to the user that the reader/device is ready for operating/scanning or to indicate a successful scan. Applicants believe that the generic nature of the proposed motivations to combine indicate that the proposed combinations were derived as a result of impermissible hindsight.

The Examiner has a burden of demonstrating that there exists a motivation, suggestion, or teaching to combine the teachings of two or more patents, which motivation, suggestion, or teaching must be found independent from the teachings of the application being examined. See *In re Werner Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000). The Federal Circuit stated *In re Werner Kotzab* at pages 1369-70 (citations omitted):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claims is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not "evidence."

The applicants respectfully assert that the Examiner has presented reasons for combining references that do not represent a convincing line of reasoning to combine references. For example, the rationale given for combining Banerjee with Koenck/Davis – that the combination would provide a user capability to view stored image data in order to verify the accuracy of scanned images – is nonsensical and illogical. As best understood Koenck (see Fig. 3) has an on-device RAM 75 for storing scanned images and an on-device CPU 74 which is able to retrieve scanned images from RAM 75 and process them into such form that they can be displayed on display 13. Accordingly, Koenck, without modification, already has all of the advantages the Examiner attributes to the combination of Koenck/Davis and Banerjee. Because Koenck already has the purported advantages the Examiner attributes to the combination of Koenck/Davis and Banerjee, the skilled artisan would not be motivated to modify Koenck in accordance with another reference in order to realize those advantages. Incorporating the display system of Banerjee as that system is best understood into Koenck would also destroy the functionality of Koenck's display system. See *In re Ratti*, 270 F.2d

810, 813 (CCPA 1959) (the “suggested combination would require substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which [the primary reference] construction was designed to operate”), cited in MPEP §2143.01.

Regarding further insufficiencies of the Examiner’s action, the applicants note that certain limitations of applicants’ claims have not been adequately addressed. When claims are rejected for obviousness, the prior art must teach each element of the claimed invention. MPEP §2143. Further, when a reference is complex the particular part of the reference relied upon *must* be designated as nearly as possible (emphasis added). 37 C.F.R. §1.104(c)(2).

While the Examiner has pointed to sections of references that appear to generally describe communications between a host computer and a portable device, applicants’ present claims specifically require an optical reader which actuates a component in response to a received instruction substantially on receipt of the instruction. The Examiner has failed to point to specific sections of the relied upon art which the Examiner regards as satisfying the various “substantially on receipt” elements of applicants’ claims. As indicated above, applicants believe the Examiner has not established that there is motivation to modify Koenck in accordance with Banerjee. Even if there was motivation to modify Koenck in accordance with Banerjee (which the Examiner has not established), the Examiner has not alleged that the combination of Banerjee with Koenck/Davis teaches all the limitations of claims 71 and 76. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) cited in MPEP §2143.03.

Notwithstanding the Examiner’s failure to point out specific sections of Banerjee relied upon, applicants have read Banerjee in an attempt to identify sections of that reference which might be considered to satisfy the “substantially on receipt” element of applicants’ claims.

Overall, applicants find that the technology descriptions of Banerjee are difficult to follow. Nevertheless, applicants note the reference to a processing delay “near or below the human perception level” (column 11, lines 30-32 in Banerjee). Applicants also note the statement of Banerjee that “without local linking, a high bandwidth communication link is required to meet the preprogram delay requirement. Such a high bandwidth communication link is impractical, both in terms of cost and its impact on the portability of the resulting viewer device.” (column 11, lines 41-45). A prior art reference must be considered in its entirety *i.e.*, as a whole, including portions that would lead away from the claim invention. *W. L. Gore Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 (Fed. Cir. 1983) cited in MPEP §2141.02.

In addition, applicants note that the Examiner has grouped claims 71, 73-76, 79-80 and 83 and has further grouped claims 72, 77-78, and 81-82. The Examiner is respectfully reminded of the provision outlined in MPEP §707.07(d) that “a plurality of claims should *never* be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” (emphasis added) Applicants note that each of the grouped claims 71, 73-76, 79-80, and 83 and 72, 77-78, and 81-82 recite distinct combinations of elements.

Still further, regarding claims 76, 79, 81, and 83, the Examiner relied on Davis as providing motivation for incorporating a wirelessly received beeper command as recited in those claims. The Examiner’s assertion that Davis wirelessly sends a beeper command in accordance with the specifically recited claims should be reconsidered in view of the actual teachings of Davis, wherein the purportedly pertinent beeper system appears to part of a system in which a portable device is coupled to a host via an input/output connector 80.

Applicants have amended claim 76 in an effort to clarify distinctions between the claim 76 and the relied upon prior art. Claim 76 now recites an artificial light source controlled by component control instruction which directs light toward a target indicia as in original claim 78. As best understood, original claim 78 was rejected based on a combination of Roslak with Koenck, Banerjee and Davis. Applicants have previously asserted that the combination of Roslak is improper at least in that such combination evidences a derivation

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based on hindsight. Applicants further assert that even if a combination based on Roslak were proper (which it is believed has not been established) the combination of Roslak and Koenck would not yield the claimed invention. Specifically a combination of Roslak with Koenck would not yield the claim elements relating to an artificial light source which directs light toward a target when receiving a component control instruction. In that the purportedly pertinent sections of Roslak appear to discuss an indicator light that does not direct light toward a target, the Examiner is respectfully requested to explain why the skilled artisan, taking the teachings of Roslak (assuming for purposes of discussion that Koenck and Roslak are combinable) would be motivated to modify Koenck in accordance with amended claim 76 reciting a light source directing light toward a target.

Applicants also submit new claims 97-107 which are believed to be allowable for the reason that they recite combinations of elements not shown or suggested in the prior art.

Accordingly, in view of the above amendments and remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

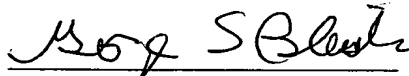
The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

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Respectfully submitted,

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